

(1) DO NOT SCAN THIS DOCUMENT INTO IFW.

(2) This document should be placed into an Examiner Note folder for this application.

**PATENT EXAMINER
IFW REISSUE APPLICATION CHECKLIST**

3/24/04

Examiner:

Pedro Philogene

Art Unit :

3732

Reissue Appl. No.:

10 1629,788

THIS CHECKLIST IS PROVIDED AS AN AID TO THE REISSUE EXAMINATION PROCESS. IT SHOULD BE USED THROUGHOUT PROSECUTION AND MUST BE REMOVED FROM THE FILE AT THE TIME OF ALLOWANCE AFTER APPROVAL BY THE SPRE.

Reissue applications are considered "SPECIAL" (MPEP § 1442). Any reissue application appearing on an examiner's docket report should be taken up for action as the next new or amended case, even before other special applications.

Prior to examining a reissue application, the examiner should obtain and review the original patent file if the patent issued from a paper application, or access the file history if the patent issued from a paper application. MPEP § 1440. Examination of the reissue application is frequently directly linked to the prosecution history of the original application for the patent to be reissued.

ALL CLAIMS IN THE REISSUE APPLICATION ARE SUBJECT TO A FULL EXAMINATION ON THE MERITS, INCLUDING THE RE-PRESENTED ORIGINAL CLAIMS OF THE PATENT.

Examiner: Complete items 1-20 prior to completing a first Office action. **Then, before mailing the action, send an IFW message to the SPRE and hand carry this form to the SPRE.**

 (SPRE initials) SPRE has reviewed before first action. **This form is then returned by the SPRE to the examiner for storage.**

Examiner - Complete items 21-22 when preparing the reissue application for allowance.
SPRE - Place his/her initials of approval on the Reissue IFW SPRE final review form that is scanned into the file history at the time of review for allowance.

IFW Reissue Application Checklist

A "Reissue Guide" containing a further explanation of each of the items on the checklist is available in paper form or electronically (by e-mail) from the Technology Center SPRE or Paralegal.

Indicate that each of the applicable items set forth below has been thoroughly reviewed with respect to the above-identified reissue application by answering YES, NO, or N/A to the following questions. See TC SPRE for further assistance, if needed.

- / 1. Has the original patent file wrapper in paper, or file history in IFW, been obtained and reviewed? If NO, see "Reissue Guide" for further assistance.
- / 2. Is the (original) patent still in force, i.e., has not expired due to the conclusion of its term or due to the non-payment of the scheduled maintenance fees? A reissue application must actually issue as a reissue patent before expiration of the original patent. Accordingly, always make sure the patent will not expire during prosecution of the reissue application. See "Reissue Guide" for methods of checking patent term.
- / 3. Has notice of the filing of the reissue application been published in the *Official Gazette* (O.G.)? If NO, STOP action and have your TC Paralegal forward the application to OIPE to effect publication. Reissue RCEs are not announced in the O.G.
- / 4. Is the current date more than two months after the O.G. publication date? ? If NO, wait until the two-month period has expired before preparing and issuing an Office action, unless directed otherwise by a decision of the Office of Patent Legal Administration or Office of Petitions in the file. Continuation/divisional reissues may be acted upon before the expiration of the two-month period.
- / 5. Has the file been reviewed for the presence of any protests under 37 CFR 1.291(a)? Protests may be filed during the two-month period following the O.G. notice, or anytime up until the Notice of Allowance, and should be considered in the next Office action, if in the file. See "Reissue Guide" for instructions on handling protests.
- / 6. Is the reissue application a division or a continuation of another pending reissue application, or is there a child reissue application that is a division or continuation of this application? See *In re Graff*, 42 USPQ2d 1471. If YES, special handling as per "Reissue Guide" is required. See Item 19 below for restriction practice.
- / 7. Is the patent or the reissue application involved in litigation? Information may be found in file or requested from STIC. If YES, shortened reply periods may have to be set by the

IFW Reissue Application Checklist for Paper Reissues

Examiner, or prosecution may have to be suspended. See "Reissue Guide." If NO, proceed with examination.

- Y 8. **If the reissue application has been assigned, does it include the written consent to the filing by all of the assignees (37 CFR 1.172(a))? See MPEP § 1410.01. If NO, and a petition for a waiver of this requirement has been granted, the assent may be deferred until the case is otherwise allowable.**
- Y 9. **Have all documents (in applications filed on or after September 24, 1992) which are signed by, or on behalf of, the assignee(s) been checked and found to comply with the provisions of 37 CFR § 3.73(b)? This includes "consent" in No. 8, above. If NO, the statement under § 3.73(b) must be required before allowance.**
- N 10. **Were any changes made to the patent by a Certificate of Correction dated prior to the filing of the reissue? If YES, check to see if the changes were properly entered as though part of the original patent, i.e., no brackets or underlining.**
- Y 11. **Has the application been reviewed for the presence of any errors, including any not specifically identified, which are not correctable by reissue? Reissue doesn't cure all patent ills. See "Reissue Guide" for listing of some errors which cannot be corrected by reissue.**
- N 12. **Are any claims broader in scope (in ANY respect) than the original patent claims? If YES, note 35 USC 251, 3rd and 4th paragraphs. If NO, proceed to item 14.**
- 13. **Does the broadening (from Item 12) attempt to "recapture" any claimed subject matter which was deliberately added, or argued, to overcome a rejection in the original application? See "Reissue Guide" for explanation of "recapture doctrine." Subject matter deliberately surrendered may not be recaptured (reclaimed) in a reissue application.**
- Y 14. **Has: (1) the original patent been surrendered OR (2) does the application contain a statement that the original patent is lost or misplaced? If NO, the application can't be allowed until either (1) or (2) is obtained.**
- N 15. **Does the reissue application seek to provoke an interference with another patent? If NO, proceed to Item 17. If YES, see "Reissue Guide."**

IFW Reissue Application Checklist for Paper Reissues

 16. Do the issues of interference estoppel and the "lost count" doctrine apply? *Applies to losing party of an interference. See "Reissue Guide."*

✓ 17. Does the application include drawings (copies or originals) which meet the requirements of 37 CFR 1.84? *If YES, be sure there are no amendments or additions to the original figures. Transfer of the drawings from the patent file is not done by the Office.*

✓ 18. Does the reissue oath or declaration comply with all of the requirements of 37 CFR § 1.63 and 37 CFR § 1.175? *See list of requirements in "Reissue Guide." If NOT, reject under 35 U.S.C. 251 (citing relevant portion of 37 CFR 1.63 or 1.175).*

N 19. Does the reissue application contain claims to more than one invention? 37 CFR 1.176. *If yes, and the several inventions were claimed in the patent, a restriction requirement dividing the several inventions cannot be made in the reissue. If added claims in the reissue are drawn to an invention not previously claimed, a restriction is possible. See Reissue Guide.*

N 20. Is the original patent currently involved in a reexamination proceeding? *To determine this, check "Continuity" in PALM for the original patent number. If YES, forward all related files (including any reexam or reissue directed to the original patent) to the Office of Patent Legal Administration (OPLA) for consideration of a merger of the proceedings.*

THE FOLLOWING QUESTIONS SHOULD BE COMPLETED WHEN PREPARING THE APPLICATION FOR ALLOWANCE:

 21. Have all amendments to the specification, drawings and claims been reviewed and found to comply with 37 CFR § 1.173(b)? *See amendment practice described in "Reissue Guide." If NO, amendment in accordance with § 1.173(b) will be required.*

 22. The following items should be verified at the time of Allowance:

- a. None of the original patent claims have been renumbered.
- b. Final numbering of claims added by reissue must follow the number of the highest numbered patent claim.
- c. The claim selected for printing is one which was added or amended during reissue - never a canceled claim. (Where no claim is amended/added, print the same claim printed in the original patent).
- d. On the Issue Classification sheet, the final claim numbering must be filled in properly. A canceled patented claim retains its original number although not considered in the total number of claims allowed. Therefore, on the Issue Classification Sheet, the number in the box designated "TOTAL CLAIMS ALLOWED" may be less than the highest number of the last allowed claim.

Reissue Application Checklist for Paper Reissues

- _____ e. Any Examiner's Amendment which makes a change to the patent which change is substantive in nature may necessitate a supplemental reissue oath/declaration from applicant.
- _____ f. Classification and cross referencing on the Issue Classification Sheet should include at least those classes and subclasses designated on the original patent. If a reclassification prevents use of the same class/subclasses, the new class/subclasses should be used.
- _____ g. Terminal Disclaimer (TD) information has been placed in the IFW file wrapper for TDs filed either in the original patent or in the reissue application.
- _____ h. The references cited in the original patent have been cited in the reissue application on a Form PTO-892 or PTO-1449.
- _____ i. For any error corrected, which is not covered by an oath or declaration, i.e., any error corrected after the filing of all declarations currently in the reissue application, applicant **MUST** submit a supplemental oath or declaration prior to allowance stating "*[T]hat every such error arose without any deceptive intention on the part of the applicant*" (37 CFR 1.175(b)(1)), or language equivalent thereto. See MPEP 1444 for handling supplemental oaths/declarations.

The red Action folder including the Issue Classification Sheet for each allowed reissue application, together with the original patented file, if in paper, is submitted to the TC SPRE for review prior to being released from the Technology Center. Approval of the reissue is to be initiated by the TC SPRE on one of the papers that are scanned into the file history. The SPRE should also enter original patent number, where the SPRE initials. Once the reissue has been approved and revised for issue, the red Action Folder and any paper files should be sent to the Office of Patent Legal Administration.

This checklist is to be removed from the Action Folder by the SPRE at the time of final review.

All reissue applications are screened by the Office of Patent Legal Administration (OPLA). Thus, the office of the SPREs will "message" the OPLA IFW reissue mailbox, after the TC has finished working on the case, e.g., counted, mailed, and image uploaded to IFW of all work.

Examiner: _____

Date: _____